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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/682,349

10/09/2003

Stephen M. Zaudtke

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11/28/2005

EXAMINER

SHIN, CHRISTOPHER B

HEWLETT-PACKARD COMPANY

Intellectual Property Administration

P.O. Box 272400

Fort Collins, CO 80527-2400

ART UNIT

PAPER NUMBER

2182

DATE MAILED: 11/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/682,349

Applicant(s)

ZAUDTKE ET AL.

Examiner

Christopher B. Shin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. On September 14, 27, and 29, the examiner and Mr. Dan C. Hu had extensive discussions in an attempt to expedite the prosecution. The examiner thanks Mr. Hu for the helpful cooperation. During the discussions, the examiner found the claimed term "emulation", "emulating", "emulate" not clear from the context of the claim. The examiner kindly asks the applicant to clarify the claimed "emulate" in response to this office action.

Double Patenting Rejection

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-30 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 6,654,816. Although the conflicting claims are not identical, they are not patentably distinct from each other because, as can be seen from the

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combinations of claims 1, 2 & 6 of the (816) patent, the emulation function seems to be performed or provided by the (816) patent. Therefore, the present claims are obvious over the parent patent (816) patent.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

4. Claims 1-30 are provisionally rejected under the judicially created doctrine of double patenting over claims 16 and more of copending Application No. 10/682,348. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: The claim 16 of the (348) teaches the basic inventive concept of claims 1, 8, 20 and 23; furthermore, the rest of claims of (348) basically teaches the claims (2-7, 9-19, 21-22 and 24-30).

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 5, 8, 9, 20 and 23 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Billick et al. (6,807,629).

a. As per claim 1, a computer diagnostic system, comprising: a computer (Fig. 1: #100) with a communication port (#113); an I/O system (#114) that enables communication via the communication port during power up self test (POST) of the computer (COL.2: lines 25-30); and a handheld device with a communication port configured to communicate with the computer via the computer communication port, the handheld device interfacing with the computer during POST (Col.2: lines 34-38; Col.3: lines 11-15)

b. Due to the similarity between the claims 1 and claims 5, 8, 9, 20 & 23, the claims 5, 8, 9, 20 & 23 are rejected for the similar rationale/reason.

7. Claims 1-5, 8-30 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Woodruff (6,438,711).

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c. The examiner would like to clarify the interpretations of the claimed "handheld device" as supported in pages 14 (line 19) –15 (line 1). The supported section states "*The handheld device (123) may comprise any types of portable device, palm device (e.g., the Palm PC or PPC), handheld device, notebook computer, or any type of personal digital assistant (PDA) device or the like, such as the Palm Pilot by 3COM, etc. The handheld device 123 includes any associated operating system, such as windows CE or the like.*" As can be seen from the specification, the handheld device includes, "notebook computer" and/or "operating system such as windows CE or the like"; consequently, the examiner interprets the handheld device to be a personal computer. This is because, at the time of the invention, the notebook computer and /or windows CE or the like operating system are clearly in the category of personal computer. Furthermore, at the time of the invention, the "notebook computer" are known to have full equivalent functions as larger personal computing system category.

d. With the above interpretations, the Woodruff reference teaches all of the limitations of the claimed invention; therefore, the claims 1-5 & 8-30 are clearly anticipated by the teachings of the Woodruff reference.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Woodruff in view of Tagnazzini (US 2002/0029295 A1).

e. The teachings of the Woodruff are similarly applied here.

f. The claim 6 further adds limitations regarding communication means such as the claimed infrared transceiver. However, such limitation is well known and commonly utilized in the art of communication. As can be seen from the Woodruff reference, the Woodruff reference clearly motivates to use "other transmission media"/"other connection", in (column 2, lines 24 and 29). In addition, the Tagnazzini reference clearly teaches the IR communication means, in page 3 [0046]. For the above reasons, it would have been obvious at the time invention was made to one having ordinary skill in the art to combine the two reference to come up with the invention, for the reasons state above.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher B. Shin whose telephone number is 571-272-4159. The examiner can normally be reached on 6:30-5:00 M,Tu,Th,F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Huynh can be reached on 571-272-4147. The fax

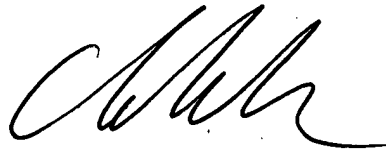
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phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christopher Shin
Primary Examiner
Of 2182

October 21, 2005
cbs

A handwritten signature in black ink, appearing to be 'C. Shin', written in a cursive style.